

REMARKS

Claims 9-11, 13-30 and 32-40 are pending in this application.

Applicant acknowledges Examiner's indication that Applicant's submission filed on September 8, 2008 has been entered and that it resolves the rejection under 35 USC § 112. This is a response to the Examiner's request for reasons why the cited cases are not applicable.

Double Patenting

The Examiner has rejected claims 9-11, 13-30 and 32-34 as allegedly being unpatentable over claims 1-20 of U.S. Patent No. 7018997 (hereinafter referred to as "the '997 patent") on the basis of obviousness type double patenting. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the process of preparing the compounds of the present invention is not obvious from the claimed compounds of the '997 patent. Designing processes to produce various compounds takes extensive experimental work. Nothing in the compound claims suggests the claimed method.

For a claim to be unpatentable based on obviousness-type double patenting, it must be obvious from the language of the claims in the cited patent. A claim to a compound does not make a claim to a method for making the compound obvious unless it discloses or suggests the process as a whole. If this were not true, then a compound claim would make unpatentable all claims to processes for making the compound; to the contrary, a new process for making an old compound is patentable subject matter. In the present case, the patented compound claims do not disclose or suggest the process of the pending claims.

The Examiner has cited several court decisions to support his rejection, but has misinterpreted or misapplied the case law, as is explained below.

The Examiner has cited the 1888 Supreme Court case of *Mosler Safe & Lock v. Mosler, Bahmann & Co.* However, this was a "purely mechanical case" in which the court found that the claimed method was "an old method" which involved "no exercise of the inventive faculty". In 1894, the Supreme Court clarified that *Mosler* must be

confined to its exact facts, and stated that “a single invention may include both the machine and the manufacture it creates, and in such cases, if the inventions are really separable, the inventor may be entitled to a monopoly of each.” Miller v. Eagle Mfg. Co., 151 U.S. 186, 197, 14 S.Ct. 310, 38 L.Ed. 121 (1894).

Unlike in *Mosler*, the process at issue here is not purely mechanical. Nor is there any argument that the process is not new or that the process is merely the use of an old method that requires no inventive faculty. Neither *Mosler* nor any other Supreme Court case broadly prohibits an inventor from receiving a process patent after earlier obtaining a product patent where the inventor could have presented the claims in a single patent. Takeda Pharmaceutical Co., Ltd. v. Dudas, 511 F.Supp.2d 81, 84 U.S.P.Q.2d 1365, (D.D.C. Sep 18, 2007).

The Examiner has cited *In re Freeman*, in which product claims were found to be obvious based on process claims. However, in that case the product was defined by the process, i.e., they were product by process claims; this is not the case here.

The Examiner also states that it does not matter whether the compound claim or the process claim is patented first. Applicants strongly disagree. A process for making compound X must disclose compound X, but a claim to compound X need not disclose a process. In the present case, the cited patent claims do not teach or suggest the presently claimed process.

The Examiner’s citation of *Ex parte MacAdams* is also not on point. The claims that were rejected were claims for a method of using a product in the manner in which the product was designed to be used. The case contains *dicta* that, “method claims drawn to the generally conventional method of making a composition are obvious.” However, there is no generally conventional process for making the compound of the present invention. Applicants method was the result of extensive research, and is not obvious merely from knowledge of the compound to be made.

The Examiner has cited additional cases (*Geneva Pharmaceuticals*, and *In re Boylan*) which are also relating to methods of using rather than methods of making, and has stated that he cannot see any reason why these two situations should be treated differently. However, they are different. The Examiner has erroneously used a rote analysis, rather than applying the proper standard for obviousness.

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In a proper obviousness analysis, the Examiner should consider the differences between the patent claims and the pending claims and determine whether the differences are obvious from the patent claims. In this case, the process steps of the pending claims represent a significant difference from the patent claims; the Examiner has not provided any reasons to support his assertion that these process steps are obvious from the patent claims. Applicants claim a specific multi-step process. In view of the known unpredictability of the chemical arts, it is certainly not obvious from the mere knowledge of the end product.

Furthermore, it is highly likely that the compound could be made by other processes. Nothing in the compound claims would lead one of ordinary skill to the particular process claimed by Applicants.

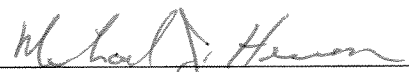
CONCLUSION

Applicants believe that the foregoing constitutes a complete and full response to the Action of record. In view of the above remarks, Applicants respectfully submit that the rejections of record have been overcome, and the pending claims are now in form of allowance. Therefore, allowance of the application on the merits is respectfully requested.

No fees are believed due. However if any fees are found to be due, the Commissioner is hereby authorized to charge the fee required and any additional fees that may be needed to Deposit Account No. 01-1425, in the name of Wyeth.

Respectfully submitted,

Date: 10/9/08



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